

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARNETT R. WEBER

Application 10/701,997

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences (BPAI) on September 22, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matter(s) requiring attention prior to docketing are identified below:

Appellant filed an Appeal Brief on March 17, 2005. The examiner mailed an Examiner's Answer on June 2, 2005. Neither the brief nor the answer is in full compliance with the new rules under 37 CFR § 41.37 effective September 13, 2005.

In reference to the brief, the new rules as per 37 CFR § 41.37(c) states in part::

(c)(1) The brief will contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a

separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix*. An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

An in-depth review of the Appeal Brief indicates that the following section headings are missing from the Appeal Brief filed February 22, 2005:

- 1) "Grounds of Rejection to be Reviewed on Appeal" as set forth in 37 CFR § 41.37(c)(1)(vi);
- 2) "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 3) "Related Proceedings Appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

Also, the *Summary of claimed subject matter* provided by the appellant is not in compliance with 37 CFR § 41.37(c)(v).

A substitute brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark website www.uspto.gov, and, in particular, the web page entitled "More Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule" located at the following URL: www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

Also, a revised examiner's answer that corresponds to § 41.37(c) is required. For the required content in an Examiner's answer under the new rules, the examiner is directed to the Manual Of Patent Examining Procedure (MPEP) § 1207.02(A) (8th ed., Rev. 3, August 2005) which states in part:

Briefs must comply with 37 CFR [§] 41.37, and all examiner's answers filed in response to such must comply with the guidelines set forth below.

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

(1) *Real Party in Interest*. A statement acknowledging that the brief has identified by name the real party in interest.

(2) *Related, appeals and Interferences*. A statement identifying by application, patent appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph should be included in the Related proceedings appendix section.

(3) *Status of Claims*. A statement of whether the examiner agrees or disagrees with the statement of the status of claims contained in the brief . If the examiner disagrees with the statement of the status of the claims contained in the brief, the examiner must set forth a correct statement of the status of all the claims in the proceeding.

(4) *Status of Amendments After Final* . A statement of whether the examiner agrees or disagrees with the statement of the status of amendments contained in the brief and an explanation of any dis- agreement.

(5) *Summary of Claimed Subject Matter*. A statement of whether the examiner agrees or disagrees with the summary of claimed subject matter contained in the brief and an explanation of any disagreement

(6) *Grounds of Rejection to be Reviewed on appeal*. A statement of whether the examiner agrees or disagrees with the statement of the grounds of rejection to be reviewed set forth in the brief and an explanation of any disagreement.

(7) *Claims Appendix*. A Statement of whether the copy of the appealed claims contained in the appendix to the brief is correct and, if not, a correct copy of any incorrect claim.

(8) *Evidence Relied Upon*. A listing of the evidence relied on(e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

(9) *Grounds of Rejection*. For each ground of rejection maintained by the examiner and each new ground of rejection (if any), an explanation of the ground of rejection.

(10) *Response to Argument*. A statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention. The examiner must use headings and subheadings paralleling the headings and subheadings utilized in the appellant's brief.

(11) *Related Proceedings Appendix*. Copies of any decisions rendered by a court or the Board in any proceeding identified by the examiner in the "Related Appeals and Interferences" section of the answer.

Consequently, the heading *Prior Art of Record* in the examiner's answer, should be replaced by the heading *Evidence Relied Upon*, and should list the prior art of record being applied therein.

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Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed March 17, 2005, defective and notification to appellants to file a substitute Appeal Brief in full compliance with 37 CFR § 41.37;
- 2) for consideration of the substitute Appeal Brief, to vacate the Examiner's Answer mailed June 2, 2005, and issue a revised Examiner's Answer in accordance with the new rules effective September 13, 2004; and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:



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